

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AB87
[Docket No.: 2005-P-055]

For: **Notice of Proposed Rulemaking:
Changes to the Practice for
Handling Patent Applications Filed
Without the Appropriate Fees**

**70 Fed. Reg. 9570
(February 28, 2005)**

***Comments In Reply To the Notice of Proposed Rulemaking Entitled
"Changes to the Practice for Handling Patent Applications Filed Without
the Appropriate Fees"***

Mail Stop Comments - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Notice of Proposed Rulemaking published February 28, 2005, at 70 Fed. Reg. 9570, the PTO Practice Committee at Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

The Office is proposing that each 2 Kb of information on a CD will be considered to be one page. However, in many, if not most cases, this would result in page fees in excess of what those fees would have been if the information had been submitted on paper. That would deter the submission of large tables on CD, which is the opposite of what the Office desires.

For example, one table in an application that we are handling is 21,496 KB and it prints as 5,081 pages. If we submitted this on CD, a page fees of 2 KB/page would result in our having to pay for 10,748 pages just for that table. This is almost twice the size for submission of a printed copy. Submitting this table on CD under the proposed rules would cost about \$54,000.

The size fee should be tempered for electronically submitted information, especially sequence-related tables. As with sequence listings, an examiner would search such tables electronically rather than reading through the data page by page. Thus, having the data submitted in electronic form significantly lessens the handling burden on the Office, and an unlimited per page fee is unwarranted.

Accordingly, we recommend that there be an "upper limit" for the fees applied to electronically submitted tables, at least for sequence-related tables, similar to that provided for by Part 8 of the Administration Instructions (AI) under the Patent Cooperation Treaty. Under AI Section 801(a), a PCT receiving office may accept sequence listings and sequence-related tables filed in electronic form, e.g., on a compact disk. AI section 803 provides that when the sequence listing and sequence-related tables are filed in electronic form, the total fee for the electronic submission will 400 times the per sheet fee (currently, \$5,200).¹ Thus, for submissions which would exceed 400 pages, a cost savings is provided to the applicant, commensurate with the significantly decreased handling burden on the Office. Furthermore, there is no need to estimate "page equivalents" in KB, because the submission has a flat fee.

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,
Sterne, Kessler, Goldstein & Fox P.L.L.C.

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¹ The US Receiving Office accepts sequence listings and sequence-related tables in electronic form under AI Section 801(c) as long as certain guidelines are met. See <http://www.uspto.gov/web/offices/pac/dapps/pct/aipart8.html> (visited March 29, 2005).